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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,334	04/12/2004	Joseph Russo	15594US01	3123

23446 7590 02/10/2006
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EXAMINER

VALENTI, ANDREA M

ART UNIT PAPER NUMBER

3643

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/822,334

Applicant(s)

RUSSO, JOSEPH

Examiner

Andrea M. Valenti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election of Group 1 (claims 1-8) in the reply filed on 20 December 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,918,411 to Hadrava.

Regarding Claim 1, Hadrava teaches a system for collecting landscape trimmings, the system comprising a plurality of rigid pieces (Hadrava Fig. 3 and 4 element #10a and 10b), the pieces adjoining to form a receptacle (Hadrava Fig. 1 and 2) around an object, the receptacle having an opening (Hadrava Fig. 3 and 4 #17a and 18a create the opening) for the object allowing the receptacle to surround the object; an outer raised edge (Hadrava Fig. 1 #14 and 14a) on the receptacle for containing the landscaping trimmings to the receptacle; and an inner raised edge (Hadrava Fig. #17a and 18a) on the receptacle for containing the landscaping trimmings to the receptacle.

(The Examiner considers the claim language identified in italics above to be a functional limitation, i.e. intended use. While features of an apparatus may be recited either

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structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone. Since the structural limitations have been met by the prior art, the functional limitation can be performed by the prior art structure. See MPEP 2114. If the prior art structure is capable of performing the intended use, then it meets the claim.)

Regarding Claim 2, Hadrava teaches the receptacle is circular (Hadrava Fig. 2 #10).

Regarding Claim 3, Hadrava teaches the receptacle is comprised of two pieces (Hadrava Fig. 3 and Fig. 4 #10a/10b).

Regarding Claim 4, Hadrava teaches wherein the receptacle is circular and the pieces comprise two halves of a circle (Hadrava Fig. 3, 4, and 2).

Regarding Claim 5, Hadrava teaches the pieces are plastic (Hadrava Col. 1 line 32, Col. 2 line 7, and Col. 4 claim 6).

Regarding Claim 7, Hadrava teaches the object is a shrub, bush, or tree (Hadrava Col. 1 line 19 and Col. 2 line 9).

Regarding Claim 8, Hadrava teaches the pieces may be different sizes (Hadrava Col. 2 line 45-46) to facilitate storage.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent No. 5,918,411 to Hadrava.

Regarding Claim 6, Hadrava teaches plastic, but is silent on explicitly teachings it is polypropylene plastic. However, it would have been obvious to one of ordinary skill in the art to modify the teachings of Hadrava at the time of the invention since the modification is merely the selection of a known plastic material selected for intended use performing the same intended function. It is merely an engineering design choice based on cost, availability of raw materials, available manufacturing equipment (e.g. molding equipment), etc. The selection of a known material for intended use does not present a patentably distinct limitation over the prior art of record [*Leshin* 125 USPQ 416].

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


German Patent DE 3121590A1; U.S. Patent No. 2,436,173; U.S. Patent No. 58,866; U.S. Patent No. 3,287,851; U.S. Patent D450,624; U.S. Patent D463,318; U.S. Patent No. 4,858,378; U.S. Patent No. 4,986,025; U.S. Patent No. 1,058,241; U.S. Patent No. 3,490,216; U.S. Patent No. 6,986,222.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea M. Valenti whose telephone number is 571-272-6895. The examiner can normally be reached on 7:00am-5:30pm M-Th.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on 571-272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Andrea M. Valenti
Patent Examiner
Art Unit 3643

06 February 2006